

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Davis et al.
Serial No. : 10/811,093
Filed : March 26, 2004
For : System and Method for Single Point of Entry Deposit
Group Art Unit : 3696
Confirmation No. : 9722
Examiner : J. Anderson

Mail Stop: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

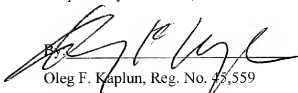
PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants hereby request review of the Final rejection in the above-identified application. No amendments are being filed with this Request. This Request is being filed with a Notice of Appeal. The review is requested for the reason(s) stated in the attached Pre-Appeal Brief.

The undersigned is an attorney of record and empowered to sign this Request.

Respectfully submitted,

Dated: February 19, 2010



Oleg F. Kaplun, Reg. No. 45,559

Fay Kaplun & Marcin, LLP
150 Broadway, Suite 702
New York, New York 10038
Tel: (212) 619-6000
Fax: (212) 619-0276

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Davis et al.
Serial No. : 10/811,093
Filed : March 26, 2004
For : System and Method for Single Point of Entry Deposit
Group Art Unit : 3694
Confirmation No. : 9772
Examiner : J. Anderson

Mail Stop: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF

In support of the Pre-Appeal Brief Request for Review filed herewith, Applicants present a pre-appeal brief in the above-captioned application.

This is a pre-appeal brief regarding the Examiner's final rejection of claims 1- 21 in the Final Office Action dated August 19, 2009

ARGUMENT

Claims 1-5 and 8-12 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Published Application No. 2005/0171899 to Dunn et al. ("Dunn").

In the Advisory Action of January 20, 2010, the Examiner responds to the argument that Dunn does not anticipate claim 1 by stating "[h]ow else can you interpret a sorting/imaging machine as cited in Dunn [0062]." The point of the argument made by Applicants is not that Dunn fails to teach a check sorting system, but that Dunn fails to teach the specific sorting recited in claim 1. That is, claim 1 recites the sorting of records "into first and second sub-files as a function of at least one of the digitized images and the data portions." The "data portions" include "data obtained from a MICR line of the corresponding check." Moreover, according to claim 1, the "first sub-file include[es] only the non-consumer checks and the second sub-file include[es] only the consumer checks."

The reliance on paragraph [0062] of Dunn is insufficient to meet this claim language. The paragraph states that checks are sorted into pockets 305 "depending on how checks are to be handled." Moreover, the sorting in Dunn "is performed based on the large account table (LAT) 310, which is a data file containing routing and account numbers and an indication of how checks for each account are to be processed, e.g., whether the checks are to be truncated." Figure 7 of Dunn illustrates pockets 305 with designators C1, C2, E1, E2, S1. No portion of Dunn describes any of these pockets as corresponding to consumer checks only or non-consumer checks only. Since the Examiner asserts that Dunn anticipates claim 1, the absence of an express teaching of these pockets as being consumer only or non-consumer only means that the pockets of Dunn would have to inherently be directed to consumer only or non-consumer only checks. The Examiner offers no evidence or reasoning in support that such a feature would be inherent to Dunn. The use of a large account table LAT 310 to sort the checks in Dunn is to no avail in

establishing such inherency, since Dunn is too vague in describing the specific use of LAT 310 for one of ordinary skill in the art to conclude that the use of LAT 310 would necessarily involve sorting checks into non-consumer only and consumer only checks.

As for the assertion that the non-consumer files and consumer files of the claim are nothing more than “non-functional descriptive data” and thus do not deserve consideration by the Examiner, this characterization is inaccurate. These files are recited as including specific data, namely, data common only to consumer checks and data common only to non-consumer checks. This is evident by the recitation that the content (i.e., “records”) of these sub-files are processed. If a check is consumer or non-consumer based on the data in a record that electronically represents these checks, and if electronic data is recognized as a legitimate claim limitation (i.e., something that is not to be dismissed as merely “non-functional”), then it follows that the recitation of one sub-file for consumer checks only and another sub-file for non-consumer checks only is a limitation on the scope of the claim that ought to be given patentable weight by the Patent Office.

Moreover, the characterization of these files as “design choices” in an anticipation rejection is misplaced. Design choice, to the extent it can be relied as a basis for rejecting claims, is proper for obviousness rejections. This is a rejection based on anticipation, which requires the prior art reference to identically teach every limitation of the claim.

Another obviousness rationale that is misplaced in this anticipation rejection is the assertion by the Examiner that the physical pockets 305 of Dunn are “interpreted to be equivalent to sub-files.” Equivalence is something that is alien to anticipation, since if anticipation means anything, it is that the prior art relied on teaches the identical thing recited in the claim, not its equivalent. Moreover, Applicants dispute the notion that physical pockets are equivalent to electronic sub-files. The Examiner provides absolutely no evidence that one of ordinary skill in the art would regard something that is physical as something that is electronic in nature. A file is embodied as electronic signals maintained in an electrically readable memory. A physical pocket

is merely a receptacle for an object - it goes without saying that there is nothing electronic about the pockets of Dunn. Thus, one of ordinary skill in the art would disagree that the sub-files recited in the claim 1 are equivalent to the physical pockets of Dunn.

Not only do the actual terms "consumer" and "non-consumer" fail to appear in Dunn, there is no passage in Dunn from which the sorting feature can be fairly implied. Paragraph [0062], on which the Examiner relies to show the sorting feature, reads as follows:

As shown in FIG. 7, paper checks presented for payment at a depository or collecting bank 102 are processed by a high-speed sorting/imaging machine 300 that reads the MICR information, sorts the checks into pockets 305 depending on how the check is to be handled, and produces a digital image of the checks. The sorting is performed based on the large account table (LAT) 310, which is a data file containing routing and account numbers and an indication of how checks for each account are to be processed, e.g., whether the checks are to be truncated.

The passage states that the sorting is performed based on large account table (LAT) 310. No explanation is provided as to why a sorting based on LAT 310 is the same as sorting checks into the sub-files of the claimed invention, nor has it been established that LAT 310 intrinsically teaches the specific kind of sorting in the claim. Therefore, it is not the case that Dunn identically teaches every limitation in claim 1.

Claims 13-15 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Published Application No. 2007/0029376 to Stoutenburg et al. ("Stoutenburg"). Stoutenburg does not anticipate claim 13 because Stoutenburg does not teach non-consumer checks or non-consumer check procedures. Stoutenburg exclusively focuses on payments by consumers at a point-of-sale (POS) device. Stoutenburg never mentions payments by non-consumers. All of the payment methods in Stoutenburg are focused on a consumer-merchant transaction.

The paragraph reads [0039] as Stoutenburg describes the versatility of a bi-directional printer with checks, but it does not describe non-consumer checks. Indeed, the "checks"

mentioned here can only mean consumer checks, since consumers are the only kind of payers mentioned in Stoutenburg. Moreover, the "payment information" that the POS device 130 analyzes is exclusively consumer-related payment information. Therefore, the POS device 130 analyzes the payment information provided by a customer not to determine whether any of it pertains to a non-consumer check, but to determine the mode of payment that the consumer wishes to use, including payment by check.

Thus, the Stoutenburg system is exclusively for allowing a customer to select the way he will pay his debts. Since the exclusive focus of Stoutenburg is on payments by consumers to merchants, every mention of checks in Stoutenburg must be regarded as a consumer check. Accordingly, withdrawal of this rejection is respectfully requested.

Moreover, as explained above, the reliance on consumer and non-consumer files as non-functional descriptive data is improper because these files contain data that is electronically operable, as evidenced by the fact that these files are consumer or non-consumer files by virtue of the records contained therein, and since these records are capable of being electronically processed, they are not non-functional.

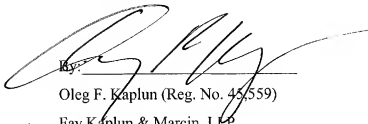
All issues having been addressed, Applicants submit that this application is in condition for allowance.

CONCLUSION

For the reasons set forth above, Applicants respectfully request that the final rejections of claims 1 - 21 be reversed and that these claims be allowed.

Respectfully submitted,

Dated: February 19, 2010


By: _____
Oleg F. Kaplun (Reg. No. 45,559)

Fay Kaplun & Marcin, LLP
150 Broadway, Suite 702
New York, New York 10038
Tel: (212) 619-6000
Fax: (212) 619-0276